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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,738	06/08/2001	Boris Viktorovich Moiseev	MOISEEV ET AL-1 PCT	9616
25889	7590	11/17/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 11/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,738

Applicant(s)

MOISEEV ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/08/2002  
2/12/2002
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The following references were listed in the specification and not on the IDS: GB 2270585 and Internet, second edition.
2. Some references in the IDS filed 2/12/02 were not considered for the following reasons: 2146821 and 0337539 lack full copies; 0451756, 3842719, 2102789, and 2085998 lack English translations and statements of relevance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: incorrect specification layout and titles. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

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- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. The abstract of the disclosure is objected to because it does not give enough detail. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. The spacing of the lines of the specification is such as to make reading difficult.

New application papers with lines 1½ or double spaced on good quality paper are required.

6. The disclosure is objected to because of the following informalities: when describing the figures in the detailed description, applicant fails to specify which figure is being referred to. Applicant needs to acknowledge all figures and reference characters in the detailed description. Appropriate correction is required.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "change of consequence" is not understood, nor is clarification available in the specification.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 21, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 21 recites the limitation "The information system" at the beginning of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "the microprocessor" at the end of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 24 and 25 contain the use of "and/or". The applicant must specify either "and" or "or".

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**11. As best understood, Claims 21-26, 28-38, and 40 are rejected under 35**

**U.S.C. 102(e) as being anticipated by Gerszberg (U.S. Patent No. 6,292,210).**

Gerszberg shows an advertising information system that includes all of the limitations recited in the above claims.

Regarding claims 21-23, 32 and 40, Gerszberg teaches a system including a user's device (which could be any number of devices) connected via a connection unit to a memory device (ISD, which examiner considers to act as a server) (Column 5, Lines 35-40). Also included into said system is a device for generating a set of requested information and advertising information (television, which examiner also considers to be an information display board) (Column 9, Lines 27-33). It is inherent that a device for displaying advertisement information (such as a television) would also have an entry for inputting advertisement information. Examiner considers the memory device above to be an advertising information memory device. Examiner considers the set-top box to be a microprocessor (Column 9, Lines 27-38).

Regarding claim 24, this claim merely specifies intended use. Further, examiner does not understand "change of consequence", and interprets any change as meeting the claim language. Thus, a television remote control as referenced by Gerszberg (Column 9, Lines 31-33) would be capable of providing a change (such as changing the channel) as stated in the claim.

Regarding claims 25 and 26, these claims merely specify intended use. The television of Gerszberg is capable of showing a video display of requested information (television programming) and advertising information simultaneously (Column 4, Lines 5-13 and Column 12, Lines 13-16 and 38-40).

Regarding claims 28-31, Gerszberg shows a user device as being any of the following: a computer (Column 5, Lines 35-38), a telephone or videophone (Column 5, Lines 35-38), or a remote control/phone combination unit (Column 3, Lines 2-4). Gerszberg also teaches a printer as being connected to a videophone (Column 7, Line 55). Claim 28 merely specifies intended use.

Regarding claim 33, Gerszberg teaches the ISD to act as a multiplexer (Column 2, Lines 59-60).

Regarding claims 34, 35, 37, and 38, Gerszberg teaches the communication network as being a telephone network (the communication in this case involves the transmitting of audio to the television) (Column 3, Lines 4-10). Gerszberg also teaches a wide area network such as the Internet as being available (Column 7, Line 3).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



13. **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (U.S. Patent No. 6,292,210).** Gerszberg teaches both the requested and advertising information as having video, but doesn't specify the advertisements as having sound. Official notice is taken that it is well known to add sound to a video advertisement shown on a television. Reference is drawn to everyday television commercials as having both video and audio. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include audio in the advertisements of Gerszberg. This would allow for a better understanding of the advertisement, as it could be heard as well as seen.

14. **Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (U.S. Patent No. 6,292,210) in view of Boylan (U.S. Pub. No. 2004/0194138).** Gerszberg doesn't specify the advertisements shown on the television as being selectable. Boylan teaches an interactive program guide on a television that has user-selectable advertisements (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to select which advertisements to view. This would allow for more sales to be made, as users are only looking at advertisements that interest them.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to advertising devices with wireless controls:

U.S. Patent No. 6,504,580 to Thompson

U.S. Patent No. 6,493,327 to Fingerhut

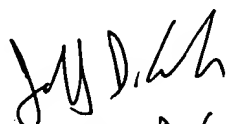
U.S. Pub. No. 2005/0216936 to Knudson

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jeffrey D. Carlson  
Primary Examiner AU 3622